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29th July 2009

PATENTS ACT 1977

Dia-Stron Limited — Applicant (Claimant)

PROCEEDINGS

Application under section 72 of the Patents Act 1977 for revocation of patent Nº GB 2,304,187 B

HEARING OFFICER Stephen Probert

DECISION

1 This decision concerns an application for revocation of a patent (GB 2,304,187) made by the proprietor of the patent. The patent is no longer in force; the register indicates that it ceased on 6 August 2007. Anyone who appeared likely to have an interest in the case was notified that proceedings had started, as required by rule 77(2) of the Patents Rules 2007. No counter-statement has been filed.

2 The proprietor, Dia-Stron Ltd, says that the patent should be revoked on the grounds of prior art that came to light when its identical European patent application was examined at the European Patent Office (EPO). I note that Dia-Stron allowed the GB patent to cease shortly after receiving the examination report from the EPO. A copy of the EPO examination report, listing the relevant prior art, is attached to the statement. I do not need to refer to Dia-Stron's European patent applicant again; any further references in this decision to "the patent" or the "Dia-Stron patent" are to the GB patent that is the subject of this decision.

3 Dia-Stron has confirmed that they do not wish to be heard in this matter, and that they are content for me to make this decision on the basis of the papers on the official file.

The Law

4 The Comptroller's powers to revoke a patent on the application of another person are set out in section 72(1) of the Patents Act. Sections 1, 2 & 3 of the Act are also relevant since they define the requirements for a patentable invention. In the particular circumstances of this case there is no need to reproduce the statutory provisions here.

The Invention

5 The invention is a method and apparatus for measuring the translucency of a material, eg. human skin. There are twenty six (26) claims in the patent, two of which are independent. Claim 1 defines the method of the invention as follows:

> 1. A method of determining the translucency of a material including illuminating the material with a radiation source, measuring the intensity of radiation leaving the material as a function of distance from the point or area of illumination, and using exponential curve fitting to determine the rate of change of the intensity as a function of distance.

No need for evidence

6 Dia-Stron has not filed any evidence in these proceedings (other than the documents attached to the original statement) — appropriately in my view; none was needed.

The Prior Art

7 The examination report from the EPO cites three patent documents —

> D1 — US 4,914,310
> D2 — WO 96/41,566 A2
> D3 — WO 97/24,075 A1

8 D2 and D3 were published after the filing date of the Dia-Stron patent (so not relevant to inventive step). Furthermore, the priority date of D3 is later than the priority date of the Dia-Stron patent (so not relevant to novelty either, assuming the Dia-Stron patent is entitled to the priority date claimed).

9 D1 discloses apparatus for, and a method of, measuring the concentration of particles suspended in a fluid. The method involves directing radiation energy into the fluid and measuring the intensity of the energy reflected by the particles at two different distances from the fluid. It calls for a similar mathematical analysis to the Dia-Stron patent in order to determine the 'gradient' (ie. rate of change) of the energy as a function of distance. D1 only refers to particles suspended in a fluid, but the 'material' in the Dia-Stron patent may be solid or fluid.

10 In the specific and somewhat unusual circumstances of this case (ie. a lapsed patent, with revocation being sought by the patentee and unopposed by anyone else) I am persuaded that the invention claimed in the Dia-Stron patent (eg. claim 1) does not involve an inventive step having regard to the disclosure of D1. I have not found it necessary to apply the usual four-step *Windsurfing*[1] approach.

Conclusion

11 I have concluded that claim 1 (at least) of the Dia-Stron patent (GB 2,304,187) does not involve an inventive step having regard to US 4,914,310. It follows

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[1] Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd [1985] RPC 59

that the patent is invalid because of a lack of inventive step as it stands. As there appears to be no prospect of any amendment of the patent under section 75, I can see no reason for me to go on and consider whether the invention in any of the other claims is either new or non-obvious. I therefore order that patent GB 2,304,187 be revoked in accordance with Section 72(1) of the Patents Act 1977.

S J PROBERT
Deputy Director acting for the Comptroller